



Docket No.: 95-424

PATENT

#7
LB
6/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

LOCKWOOD

Serial No.: 09/605,855

Filed: June 29, 2000

For: ARRANGEMENT FOR CONVERTING TELEPHONE NUMBER FORMATS FOR
NOTIFICATION SYSTEMS

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Group Art Unit: 2645

Examiner: KIDD, Marky M

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JUN 19 2003

Technology Center 2600

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the non-final Official Action dated March 17, 2003, Applicant hereby
submits the following remarks.

Reconsideration and allowance of the above-referenced application are respectfully
requested. Claims 1-30 are pending in the application.

Claims 1, 8-12, 14-15, 27, and 29-30 stand rejected under 35 USC § 103(a) in view of
U.S. Patent No. 6,389,115 to Swistock in view of U.S. Patent No. 6,324,272 to Abu-Shukhaidem
et al. Claims 2-7, 13 and 28 stand rejected under § 103 in view of Swistock, Abu-Shukhaidem et
al. and U.S. Patent No. 6,208,870 to Lorello. Claims 16 and 23-26 stand rejected under § 103 in
view of U.S. Patent No. 6,424,841 to Gustafsson in view of Abu-Shukhaidem et al. Claims 17-
22 stand rejected under § 103 in view of Gustafsson, Abu-Shukhaidem et al., and Lorello.

Each of these rejections are respectfully traversed for the reasons set forth below.

Each of the independent claims 1, 12, 16, and 27 are directed to an arrangement in a notification system for sending a notification message to a messaging server configured for identifying a user based on a destination telephone number in a first format. For example, independent claim 1 specifies a method including obtaining for the notification message a destination telephone number in a second format; converting the destination telephone number in the second format to the destination telephone number in the first format based on execution of a mapping rule selected based on a match between the mapping rule and at least a portion of the destination telephone number in the second format; and outputting the notification message having the destination telephone number having the first format.

Hence, the notification system can output notification messages to a messaging server configured for identifying the destination telephone number in the first format, independent of any further translation by an external switch or number translation resource. These and other features are neither disclosed nor suggested in the applied prior art.

Swistock discloses a customer premises system having a PBX 124, a voice mail system 122, and a customer premise internet connector (CPIC) client 126 configured for detecting SMDI signals output by the voice mail system 122. The CPIC client accesses a database 127 to locate a cell phone number associated with the voice mail number, and forwards a Notice to a CPIC server 140 via the Internet 130 based on the retrieved cell phone number, to notify the CPIC server 140 of the existence of messages. The CPIC server then sends the corresponding notifying message to the SMS system 150, causing the SMS system 150 to send the notifying message to the cell phone (see, e.g., Fig. 4).

As admitted in the Official Action:

Swistock is silent on the issue of converting the destination telephone number in the second format to the destination telephone number in the first format based on execution of a mapping rule selected based on a match between the mapping rule and at least a portion of the destination telephone number in the second format[,] and outputting the message having the destination telephone number in the first format.

[Official Action, paragraph 2, page 2]

Hence, the Official Action admits that Swistock neither discloses nor suggests any need or desirability for number translation. Further, Swistock relies on the accuracy of the cell phone number database 127 for forwarding notification messages: if a cell phone number is inaccurate or missing, Swistock prefers the database is updated by an administrator or that the message is dropped (see, e.g., col. 4, lines 15-22 and 64-67).

Moreover, the Official Action fails to provide any evidence that establishes that one having ordinary skill in the art would have been motivated to modify Swistock to include the teachings of Abu-Shukhaidem et al. The Official Action provides only a passing reference to Abu-Shukhaidem et al. as the motivation for combining references:

Abu-Shukhaidem et al. discloses a system that allows calling party telephone numbers to be manipulated such as deleting, substituting, translating, transposing and so on for the need of advanced telecommunication features (column 3, lines 4-11) [sic]. Therefore, it would have been obvious at the time of the invention to modify the method of Swistock to include the method of Abu-Shukhaidem in order to make sure that notification messages are being converted and output in the first format.

[Official Action, paragraph 2, pages 2-3 (emphasis added)]

The cited portion of column 3, lines 4-11 does not disclose the system as suggested by the Official Action; rather, the cited portion is a disclaimer that the disclosed embodiments are not intended to limit the invention.

Further, the Official Action fails to provide any evidence that one having ordinary skill in the art would be motivated to modify Swistock to include the teachings of Abu-Shukhaidem et al. The Official Action relies on the disclosure of Abu-Shukhaidem et al. per se, without any explanation for why one having ordinary skill in the art would have been motivated to add the teachings of Abu-Shukhaidem et al. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

As shown above, the Official Action fails to demonstrate how one skilled in the art would have been motivated to modify Swistock to add the teachings of Abu-Shukhaidem et al. "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Hence, the Official Action fails to establish a prima facie case of obviousness, and should be withdrawn.

Assuming one skilled in the art would have been motivated to modify Swistock to add the teachings of Abu-Shukhaidem et al., the resulting hypothetical combination still would neither disclose nor suggest the features specified in the independent claims 1, 12, or 27.

In particular, Abu-Shukhaidem et al. teaches that the manipulation is performed in a switch (e.g., see, col. 5, lines 45-49) on the calling party number to enable the called party to perform features such as automatic callback or caller ID (col. 5, lines 31-44). In contrast, the independent claims 1, 12, and 27 specify that the converting is performed in a notification system on the destination telephone number.

Hence, the hypothetical combination of Swistock and Abu-Shukhaidem et al. would merely disclose the manipulation of a calling party number, but would neither disclose nor suggest converting the destination telephone number.

For these and other reasons, the rejection of independent claims 1, 12, and 27 should be withdrawn.

The rejection of independent claim 16 is respectfully traversed. The cited portion of Gustafsson does not disclose "obtaining a notification message of a destination telephone number in a second format, and outputting the notification message having the destination telephone number in the first format"; rather, the cited portion (col. 3, lines 25-27) states: "...forwarding the acknowledgement message to the wireless client device over the wireless communications using the Short Message Service Center. [New Paragraph] As a computer readable medium including computer program code for sending messages between a client device and a server device...."

Gustafsson merely discloses exploiting unused predefined user fields in SMS acknowledgement messages by inserting within the SMS acknowledgement messages at least a portion of a deferred message awaiting delivery to the initiating unit. (See, e.g., col. 6, lines 12-28). Gustafsson neither discloses nor suggests converting the destination telephone number (for the notification message) from the second format to the first format, or outputting the same notification message having the destination telephone number having the first format, as claimed. Rather, Gustafsson sends a different message, namely an acknowledgement message, back to the initiating unit for the user having sent the original message.

As admitted in the Official Action, "Gustafsson is silent on the issue of converting the destination number in the second format to the destination number of the first format based on mapping rules".

Further, as described above with respect to the rejections of claims 1, 12, and 27, the Official Action fails to provide any evidence that one skilled in the art would have been motivated to modify Gustafsson to include the teachings of Abu-Shukhaidem et al. The Official Action parrots claim language at section 4, page 6, as the purported reason for combining the references:

It would have been obvious to one skilled in the art to modify the method of Gustafsson in order to implement the method of Abu-Shukhaidem in order to use the instructions for performing steps of obtaining the notification message in the second format, convert the second format to the first format; therefore, outputting the message in the first format.

The naked argument that copies the claim language clearly demonstrates that the Official Action is merely using Applicant's claims and specification as a template to combine the references.

However, "teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Hence, the Official Action fails to provide a prima facie case of obviousness because there is no evidence one skilled in the art would have been motivated to modify Gustafsson to include the teachings of Abu-Shukhaidem et al.

Assuming Gustafsson and Abu-Shukhaidem et al. were combined, the resulting hypothetical combination still would neither disclose nor suggest the features of claim 16. As described above, Abu-Shukhaidem et al. teaches modification of the calling party number, and not the destination telephone number, as claimed. Hence, the hypothetical combination still would neither disclose nor suggest converting the destination telephone number in the second format to the first format, and outputting the notification message having the destination telephone number having the first format for delivery to the messaging server (configured for identifying the user based on the destination telephone number in the first format).

For these and other reasons, the rejection of claim 16 should be withdrawn.

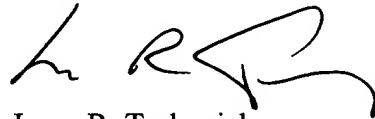
It is believed the dependent claims 2-11, 13-15, 17-26, and 28-30 are allowable in view of their dependency from the respective independent claims.

In view of the above, it is believed this application is in condition for allowance, and such a Notice is respectfully solicited.

Response filed June 17, 2003
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To the extent necessary, Applicants petition for an extension of time under 37 C.F.R.
1.136. Please charge any shortage in fees due in connection with the filing of this paper,
including extension of time fees, to Deposit Account No. 50-1130 under Order No. 95-424, and
please credit any excess fees to such deposit account.


Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L. R. Turkevich', with a stylized flourish at the end.

Leon R. Turkevich
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Customer Number 23164
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Date: June 17, 2003

2645

 REPLY/AMENDMENT FEE TRANSMITTAL	Attorney Docket No.	95-424	
	Application Number	09/605,855	
	Filing Date	June 29, 2000 RECEIVED	
	First Named Inventor	LOCKWOOD JUN 19 2003	
	Group Art Unit	2645 Technology Center 2600	
AMOUNT ENCLOSED	\$ 0	Examiner Name	KIDD, Marky M

FEE CALCULATION (fees effective 10/01/2001)

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	30	30	0 ⁽³⁾	X \$18.00 =	\$0
INDEPENDENT CLAIMS	4	4	0	X \$84.00 =	
Since an Official Action set an <u>original</u> due date of ____, petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$110); 2 months (\$400); 3 months (\$920); 4 months (\$1,440); 5 months (\$1,960)):					
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$110)					+
Total of above Calculations =					\$0
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)					-
TOTAL FEES DUE =					\$0

- (1) If entry (1) is less than entry (2), entry (3) is "0".
 (2) If entry (2) is less than 20, change entry (2) to "20".
 (4) If entry (4) is less than entry (5), entry (6) is "0".
 (5) If entry (5) is less than 3, change entry (5) to "3".

METHOD OF PAYMENT

- ☐ Check enclosed as payment.
☐ Charge "TOTAL FEES DUE" to the Deposit Account No., below.

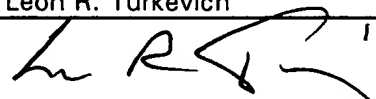
AUTHORIZATION

- ☒ If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees under 37 CFR 1.16 or 1.17 necessary to maintain pendency of the present application to:

Deposit Account No.: 50-1130

OrderNo.: (Client/Matter) 95-424

SUBMITTED BY: LEON R. TURKEVICH, ESQ.

Typed Name	Leon R. Turkevich	Reg. No.	34,035
Signature		Date	June 17, 2003